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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER I. POLTORAK

Appeal 2007-2799
Application 09/730,232
Technology Center 3600

Decided: June 26, 2008

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and ANTON W. FETTING, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 53, 66 to 72, and 86 to 88. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a method of searching intellectual property listings (Specification 1).

Claim 1 under appeal reads as follows:

1. A method of searching intellectual property listings, comprising:
 - a) maintaining a user-interface site accessible by a plurality of users;
 - b) establishing a connection to a plurality of third-party sources of intellectual property listings available for transacting;
 - c) receiving from at least one of said plurality of users search criteria for searching said plurality of third-party sources of intellectual property listings;
 - d) searching said plurality of third-party sources of intellectual property listings according to said search criteria;
 - e) presenting a resulting set of intellectual property listings to said at least one of said plurality of users; and
 - f) receiving from said at least one of said plurality of users an identification of those of said resulting set of intellectual property listings that are of interest to said at least one of said plurality of users.

The Examiner rejected claims 1, 4, 20, and 39 under 35 U.S.C. § 102(e) as being anticipated by Lundberg.

The Examiner rejected claims 21 and 45, 46, and 49 to 53 under 35 U.S.C. § 103(a) as being unpatentable over Tran in view of Fischer.

The Examiner rejected claims 22 to 38 under 35 U.S.C. § 103(a) as being unpatentable over Tran in view of Fischer and Kimball.

Appeal 2007-2799
Application 09/730,232

The Examiner rejected claims 2, 3, 5 to 7, 11 to 16, 19, 40 to 44, 47, 66 to 72 and 86 to 88 under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Tran.

The Examiner rejected claims 8 to 10 under 35 U.S.C. § 103 as being unpatentable over Lundberg in view of Boyer.

The Examiner rejected claims 17 and 18 under 35 U.S.C. § 103 as being unpatentable over Lundberg in view of Fischer and Kimball.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lundberg	US 2002/0091541 A1	Jul. 11, 2002
Tran	US 2002/0095368 A1	Jul. 18, 2002
Snyder	US 6,643,641 B1	Nov. 4, 2003
Boyer	US 6,879,990 B1	Apr. 12, 2005

Kimball, *Fundamental Grains; Technology Information*, 2 Intelligent Enterprise 60 (Mar. 30, 1999).

Fischer, *Opening the Vault; Information Exchange; Technology Information*, 20 Software Magazine 24 (Apr. 1, 2000).

Appellant contends that Lundberg does not disclose establishing a connection to a plurality of third-party sources of intellectual property listings available for transacting.

Appellant contends that Tran does not disclose searching third party sources of intellectual property listings.

Appellant also contends that there is no motivation to combine the teachings of Tran and Fischer.

Appellant further contends that the preamble of claim 45 is not just a statement of intended use and must be given weight in determining the patentability of claim 45.

Appellant also contends that Tran does not disclose executing a query.

Appellant finally contends that neither Lundberg nor Tran discloses securing from each of a plurality of third-party sources of intellectual property listings a fee sharing agreement as recited in claim 3 nor the step of reordering the intellectual property listings as required by claim 10.

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in finding that Lundberg discloses subject matter sufficient to anticipate the recitation in claim 1 of the step of establishing a connection to a plurality of third-party sources of intellectual property listings available for transacting.

The second issue is whether the Appellant has shown that the Examiner erred in finding that Tran discloses the step of searching third party sources of intellectual property listings.

The third issue is whether the Appellant has shown that the Examiner erred finding that there was a reason to combine the teachings of Tran and Fischer.

The fourth issue is whether the Appellant has shown that the Examiner erred in holding that the preamble of claim 45 is a statement of intended use and is not entitled to weight in determining the patentability of claim 45.

The fifth issue is whether the Appellant has shown that the Examiner erred in finding that Tran does discloses executing a query.

The sixth issue is whether the Appellant has shown that the Examiner erred in finding that neither Lundberg nor Tran discloses the step of securing from each of a plurality of third-party sources of intellectual property listings a fee sharing agreement as recited in claim 3.

The last issue is whether the Appellant has shown that the Examiner erred in finding that Lundberg discloses the step of reordering the intellectual property listings as required by claim 10.

FINDINGS OF FACT

Lundberg discloses a method of searching intellectual property listings including the steps of establishing a connection to a plurality of third-party sources of intellectual property listings such as patents and trademarks issued or handled by the United States Patent and Trademark Office, the European Patent Office, and the Japanese Patent Office [0007]. The records can be assessed and then added to a user's portfolio database. Additional records can be added to the user's portfolio database by specifying them one at a time or another group can be added by executing a search for a group of records with a different search criteria. The user can specify one or more additional search criteria and pare the records using a grooming function that allows the user to delete unwanted records [0011]. The user can also use a data analysis function to analyze or process the data to determine, for example, patents held in a particular area [0019].

Tran discloses a system and method of searching intellectual property listings online including an internet community that provides access to a

variety of supporting members such as prior art search firms, patent delivery firms such as the United States Patent and Trademark Office, the European Patent Office, and the Japanese Patent Office, and intellectual auctions and exchanges [0014, 0027]. The system includes a server that supports an intellectual property portal that provides a single point of integration, access and navigation through multiple enterprise systems and information sources [0016]. The system incorporates data from multiple sources in multiple formats and organizes it into a single, easy to use menu [0027]. A user of the system is prompted to provide user information such as name and email address and to create a personal profile that tracks the user's interests [0023 to 0024]. The system includes access to a search engine to continuously search the web to identify information using the user profile to form the query [0030].

Tran discloses that in one embodiment, a user can bid on an IP asset and that the seller pays all fees [0017, 0020]. Tran also discloses that a user can rent space and software on the server, ask questions of an attorney for a fee paid by the user [0023, 0027, 0031].

Fischer discloses that an organization typically has multiple sources of information in disparate databases and processing systems and that the information is exchanged using a variety of proprietary approaches such as database extracts, file transfers and batch updates (page 1, fifth paragraph). Fischer teaches that information portals provide a window to the wide array of information stored across an organization. These information portals merge data and documents that reside across disparate and heterogeneous environments and reformat data into integrated information packets that represent a meaningful snapshot of corporate information (page 3).

A query is defined as a “request for information, generally as a formal request to a database. *Computer Dictionary Online*.

ANALYSIS

Anticipation

Claims 1, 4, 20 and 39

We are not persuaded of error by the Examiner by Appellant’s argument that Lundberg does not disclose the step of establishing a connection to a plurality of third-party sources of intellectual property listings *available for transacting* as required by claim 1. Firstly, we note that, as we found above, Lundberg clearly discloses the step of establishing a connection with a plurality of third-party sources of intellectual property listings such as the United States Patent and Trademark Office, the European Patent Office, and the Japanese Patent Office. Therefore, even assuming that Lundberg does not disclose that the intellectual listings in the third party database are available for transacting the difference between the claimed subject matter and the Lundberg method is the type of data in the intellectual property listing. This difference amounts to whether the intellectual property listed is or is not available for sale or license. The type of data in the intellectual property listing does not functionally change either the user-interface site or the connection used to access the user-interface site in the method of claim 1. Nonfunctional descriptive material cannot render nonobvious an invention that otherwise would have been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the

invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: (1) a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, (2) a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), and (3) a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

In the instant case, the Appellant's argued difference is in whether the intellectual property listed is available for transacting. This difference is not a difference that is functionally related to the user-interface site or the connection. In fact, it involves the same type of data such as patents for example, the only difference being whether the patents listed are available for sale or license.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Lundberg. We will also sustain the rejection as it is directed to claims 4, 20, and 39 because the Appellant does not argue the separate patentability of these claims.

Obviousness

Claims 21, 45, 46 and 49 to 53

We will sustain the rejection of claims 21, 45, 46, and 49 to 53 under 35 U.S.C. § 103 as being unpatentable over Tran in view of Fischer. We are not persuaded of error by the Examiner by Appellant's argument that Tran does not disclose a method which includes the step of searching third-party sources of intellectual property listings. As we found above, Tran does disclose that the third party intellectual listings such as the PTO, EPO and JPO can be searched by a user using an IP search engine [paragraphs 0014, 0029].

We are also not persuaded by Appellant's argument that there is no motivation to combine the teachings of Tran and Fischer. The Appellant challenges the contention of the Examiner that freezing of data at a predetermined point in time would result in a more accurate data set.

The Supreme Court set aside any "rigid" application of the teaching, suggestion, motivation ("TSM") test, advising that: "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007). The Court instructs us that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 127 S.Ct. at 1739.

In the instant case, Tran discloses searching third party intellectual property listings and Fischer discloses the use of snapshots. A snapshot is a copy of a set of files at a particular point in time. In our view, the use of snapshots in the Tran method is no more than the combination of snapshots

as disclosed in Fischer to achieve the predictable result of having a copy of the intellectual listings of Tran at a particular point in time.

In view of the foregoing, we will sustain this rejection as it is directed to claim 21. We will also sustain this rejection as it is directed to claims 49, and 50 to 53 because the Appellant does not argue the separate patentability of these claims.

We will also sustain the rejection as it is directed to claim 45. In this regard, we are not persuaded of error on the part of the Examiner by the Appellant's argument that the language in the preamble: "for searching for a desired one of many items offered on the Internet, where said items are presented on third-party user-interface sites in multiple lists, said lists being differing formats" must be given weight in the patentability determination.

We note at the outset that the question of whether a preamble constitutes a limitation to a claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. *See In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987). The preamble of a claim does not limit the scope of the claim when it merely states intended use of the invention. *In re Pearson*, 494 F.2d 1399, 1403 (CCPA 1974). However, terms in a preamble are construed as limitations when they give life and meaning to the invention claimed. *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896 (Fed. Cir.), cert. denied, 469 U.S. 857 (1984)). "Although no 'litmus test' exists as to what effect should be accorded to words contained in a preamble, review of a patent application in its entirety should be made to determine whether the inventors intended such language

Appeal 2007-2799
Application 09/730,232

to represent an additional limitation or mere introductory language.” *See, e.g., In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994) (citing *Corning Glass Works v. Suitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)).

In the instant case, we agree with the Examiner that the preamble to claim 45 does not give life and meaning to the claim because the body of the claim does not depend on the preamble for completeness but rather the process steps of the claim are able to stand alone.

In any case, even if the preamble was accorded weight, Tran discloses searching for items presented on third-party user-interface sites in multiple lists with differing formats [paragraph 0014, 0027].

Claims 22 to 38

We will summarily sustain the Examiner’s rejection of claims 22 to 38 under 35 U.S.C. § 103 as being unpatentable over Tran in view of Fischer and Kimball because the Appellant does not address this rejection specifically in the Brief or Reply Brief.

Claims 2, 3, 5 to 7, 11 to 16, 19, 40 to 44, 47, 66 to 72 and 86 to 88

We turn now to the Examiner’s rejection of claims 2, 3, 5 to 7, 11 to 16, 19, 40 to 44, 47, 66 to 72 and 86 to 88 as being unpatentable over Lundberg in view of Tan.

We are not persuaded by the Appellant that the Examiner erred in finding that Tran discloses executing a query as recited in claims 66 and 70. Tran discloses that a search is conducted based on the customer profile. Although Tran does not use the word query, it is clear that Tran request information from the intellectual property listing based on the customer

profile. This request for information is a query. As such, we will sustain the Examiner's rejection of claims 66 and 70.

We will also sustain the rejection as it is directed to claim 68 which recites the steps of prompting a user for personal information such as name and email address and creating a user profile which is utilized to form a query. Appellant argues that claim 68 requires a personal profile and a query and Tran only discloses a profile. Firstly, claim 68 does not recite prompting a user to create a profile but rather prompting the user for personal information. This step of prompting a user for personal information is met by Tran's disclosure that the user is prompted to provide a name and email information. This personal information is separate from the user profile that is utilized to form a query.

We will sustain the rejection of claims 2, 5 to 7, 11 to 16, 19, 40 to 44, 47, 67, 69 to 72, and 86 to 88 because the Appellant has not argued the separate patentability of these claims.

We will not sustain this rejection as it is directed to claim 3 because Tran does not disclose securing from said plurality of third-party sources of intellectual property listings a fee-sharing agreement. In this regard even if we agreed with the Examiner that the payment of transfer fees by the seller is a fee sharing agreement, such payment is not done by the third party sources of intellectual property which are disclosed in Tran to be the PTO, EPO, and JPO.

Claims 8 to 10

We turn now to the Examiner's rejection of claims 8 to 10 as being unpatentable under 35 U.S.C. § 103 over Lundberg in view of Tran. We will

Appeal 2007-2799
Application 09/730,232

sustain the rejection of claims 8 and 9 because the Appellant has not advanced arguments in response to the rejection of these claims.

We will not sustain this rejection as it is directed to claim 10. In this regard we do not consider the disclosure in Lundberg that the user can specify one or more additional search criteria and pare the records using a grooming function that allows the user to delete unwanted records or that the user can also use a data analysis function to analyze or process the data to determine, for example, patents held in a particular area to meet the limitation of reordering the intellectual property listings stored in a buffer memory because the order of the listing is not changed.

Claims 17 to 18

We will summarily sustain the Examiner's rejection of claims 17 to 18 under 35 U.S.C. § 103 as being unpatentable over Lundberg in view of Fischer and Kimball because the Appellant do not address this rejection specifically in the Brief or Reply Bbrief.

In summary:

We will sustain the Examiner's rejection of claims 1, 2, 4 to 9, 11 to 47, 49 to 53, 66 to 72 and 86 to 88.

We will not sustain the Examiner's rejection of claims 3 and 10.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2007-2799
Application 09/730,232

hh

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